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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,482	04/04/2001	John C. Carson	A17-045	6243
7590	04/21/2004		EXAMINER	
COLEMAN SUDOL SAPONE, P.C. 714 COLORADO AVENUE BRIDGEPORT, CT 06605-1601			VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/826,482	CARSON ET AL.
	Examiner JYOTHSNA A VENKAT	Art Unit 1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 March 2004.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3 and 5-27 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3 and 5-27 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/24/04 has been entered.

Claims 1-3, and 5-27 are pending in the application and the status of the application is as follows:

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 8, 11, 13, 16 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 4,293,305('305).

The claims are drawn to compositions and the preamble does not carry any patentable weight.

See example 7 for propylene glycol benzoate, which is the high-density aromatic ester, claimed and see polyoxyethylene compounds, which read on the claimed surfactant. See col.7, lines 10-11, the last emulsifier reads on the claimed alkyl ether phosphates. Since the components are same claim 16 is inherent.

The specification at page 8 defines the term "phase" as "*phase means a distinct layer which appears in compositions according to the present invention after a sufficient settling period (preferably, at least about 1 minute, more often about 5 minutes or more up to about 30 minutes, and in certain embodiments, up to several days or more). Compositions according to the present invention comprise two, three or four distinct phases or layers.*

Therefore the patent anticipates the claims absence of evidence to the contrary

4. Claims 1-3, 5-6, 8-21, and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 6,043,204 ('204).

See col.4, line 64 for the claimed octyl methoxy cinnamate which is the claimed high density aromatic ester of claim 25, see also col.5, lines 44-45 for octyl salicylate which is also the claimed high density aromatic ester of claim 24, see col.6, lines 5045 for the claimed surfactants and also anionic surfactants of claims 11-14, see col.8, line 35 for lactic acids, glycolic acids which are used in the cosmetic art as exfoliating agents and it reads on the claimed exfoliating agents, see also the same column, lines 32-33 for the claimed penetration enhancers which are "propylene glycol, butylene glycol and glycerin". See col.7, lines 45-67 for the claimed low-density oil. Since the components are same, claims 6-6, and 16-17 are inherent.

The specification at page 8 defines the term "phase" as "*phase means a distinct layer which appears in compositions according to the present invention after a sufficient settling period (preferably, at least about 1 minute, more often about 5 minutes or more up to about 30 minutes, and in certain embodiments, up to several days or more). Compositions according to the present invention comprise two, three or four distinct phases or layers.*

Therefore the patent anticipates the claims absence of evidence to the contrary

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-21 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of US 2002/20160023(PGPUB '023) and U.S. Patent '204.

*The instant application is a claiming compositions comprising “*

- 1. High density aromatic ester*
- 2. Surfactant*
- 3. Oil*
- 4. Exfoliating agent.*

The PGPUB '023 teaches multi phase formulations. See examples 1 and 2 for three phase and four phase formulations. The document teaches penetration enhancers at page 1, col.1, last paragraph and col.2, paragraph 6 and oils at paragraphs 7- 8, and exfoliating agents at paragraphs

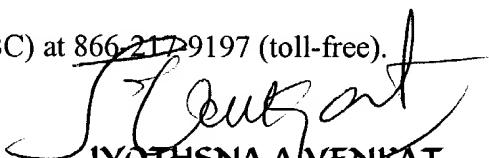
14-14. The patent at paragraph 15 suggests the incorporation of sunscreens (claimed high density esters). The difference is the document does not teach surfactants. However the patent '204 teaches surfactants in the body cleansing compositions along with other ingredients claimed.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare multiphase compositions of PGPUB document and add the claimed sunscreens and surfactants of '204 expecting beneficial effect to the skin. The motivation to add the surfactants stems from the scientific knowledge that surfactants are used mostly in cleansing compositions and the motivation to add the sunscreen into the composition stems from the '204 that these compounds provide protection against sun. One of the ordinary skill in the art would expect reasonable amount of success that by combining the surfactants and sunscreens into the compositions of PGPUB document, the compositions not only exhibit cleansing property but also protection against sun. This is a *prima facie* case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JYOTHSNA A VENKAT  
Primary Examiner  
Art Unit 1615

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